

Appln No. 10/734,517

Amdt date January 18, 2006

Reply to Office action of November 23, 2005

REMARKS/ARGUMENTS

Claims 1-4 and 6-26 are in the present application, of which claims 1, 2, 14, 18 and 25 are independent. Claim 5 was canceled previously. Claim 1 is amended herein. Applicants submit that this amendment would not require an additional search, and respectfully request that it be entered. Further, applicants request reconsideration and allowance of claims 1, 11 and 12 in addition to the allowed claims 2, 3, 14-23, 25 and 26 and allowable claims 4, 6-10, 13 and 24.

I. Rejection of Claims 1 and 11 under 35 U.S.C. § 102

Claims 1 and 11 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. Re 28,752 ("Balamuth et al."). In rejecting these claims, the Examiner contends that "Balamuth shows an ultrasonic dental insert comprising a transducer, a tip 66, a connecting body 75 disposed between and attached to the transducer and the tip, a retaining ring 81 snapped onto the connecting body, and a hand grip 52 fitted at least partially over the connecting body and retaining ring." As such, the Examiner appears to equate the O-ring 81 of Balamuth et al. with the retaining ring of the present application.

Further, in response to applicants' arguments in the amendment mailed September 6, 2005, the Examiner states that "O-rings inherently have a hole through the center, or they would be called discs." (Emphasis Added). Hence, the Examiner appears to acknowledge that an O-ring has a hole through its center, but

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not anywhere else on the ring. Applicants agree with the Examiner that a ring has a hole through the middle by definition, and thus a ring "having a hole formed thereon" means a ring having a hole in addition to the hole through the middle. Therefore, claims 1 of the instant application is patentable. To offer better clarification, Applicants have amended claim 1 to recite, in a related portion, "a retaining ring snapped onto the connecting body, the retaining ring having a hole on its periphery."

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

Applicants respectfully submit that Balamuth et al. does not teach every element of claim 1, as the o-ring in Balamuth et al. is not a retaining ring having a hole on its periphery. Further, as any formation of a hole on a periphery of an O-ring is likely to defeat its sealing purposes, "the retaining ring having a hole on its periphery" would not even have been obvious at the time the present invention was made over Balamuth et al., either individually or in any combination with other cited

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references. Therefore, Balamuth et al. fail to anticipate claim 1 nor is claim 1 obvious over Balamuth et al. Therefore, applicants request that the rejection of claim 1 be withdrawn and that it be allowed.

Since claim 11 depends from claim 1, it incorporates all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish it over the cited references. Therefore, applicants request that the rejection of claim 11 be withdrawn and that it be allowed.

II. Rejection of Claim 12 under 35 U.S.C. § 103(a)

Claim 12 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 3,809,977 ("Balamuth II") in view of U.S. Patent No. 3,654,502 ("Carmona et al."). Balamuth II has substantially the same disclosure as Balamuth et al. since Balamuth et al. is the reissue of Balamuth II. Therefore, Balamuth II does not overcome the deficiency of Balamuth et al. to reject claim 1.

Carmona et al. is being cited for the proposition that it "shows an ultrasonic tool wherein the transducer comprises a stack of nickel plates 22p. Nickel plates have a high resistivity that provides enhanced efficiency." The Examiner contends that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the crystals of Balamuth with a stack of nickel plates, in view of Carmona, in order to increase efficiency of the tool." Applicants agree with the Examiner that Applicants' transducer is not restricted to using nickel plates, and that nickel plates

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are merely described as an exemplary embodiment of Applicants' invention and that claims 1-26 cover any ultrasonic transducer. However, Carmona et al. does not disclose a "retaining ring having a hole on its periphery" to overcome the deficiency of Balamuth et al. to reject claim 1. Therefore, Applicants respectfully submit that claim 1 is patentable over U.S. Patent No. 3,809,977 ("Balamuth II") in view of U.S. Patent No. 3,654,502 ("Carmona et al.").

Since claim 12 depends from claim 1, it incorporates all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish it over the cited references. By way of example, Balamuth II and Carmona together do not teach or suggest at least "the retaining ring having a hole on its periphery." In order to establish a *prima facie* case of obviousness, in addition to meeting other requirements, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Since not all elements of claim 12 are taught or suggested by the cited references, claim 12 would not have been obvious over the cited references at the time the invention was made. Therefore, applicants request that the rejection of claim 12 be withdrawn and that it be allowed.

III. Allowable/Allowed Claims

Applicants appreciate the allowance of claims 2, 3, 14-23, 25 and 26, and request that the allowance of these claims be maintained.

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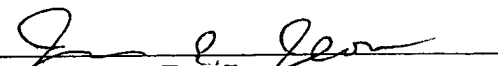
Claims 4, 6-10, 13 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Each of these claims depends, directly or indirectly, from claim 1. While claim 1 has been amended herein, applicants believe claims 4, 6-10, 13 and 24 that depend from claim 1 are still allowable as incorporating all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, applicants request that claims 4, 6-10, 13 and 24 be allowed, in addition to allowing claim 1.

IV. Concluding Remarks

In view of the foregoing amendments and remarks, applicants request an early issuance of a patent with claims 1-4 and 6-26. If there are any remaining issues that can be addressed over the telephone, the Examiner is cordially invited to call applicants' attorney at the number listed below.

Respectfully submitted,

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